



PATENT
Docket No. 110.01290101

#12
JB
8/19/02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Daniel J. O'SULLIVAN) Group Art Unit: 1651
Serial No.: 09/884,894) Examiner: D. K. Ware
Confirmation No.: 1710)
Filed: June 19, 2001)
For: BIFIDOBACTERIA AND SIDEROPHORES PRODUCED THEREBY AND
METHODS OF USE

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington D.C. 20231

Sir:

In response to the Restriction Requirement mailed July 2, 2002, Applicant elects, with traverse, Group VI (claim 29), drawn to a composition comprising a Bifidobacterium that secretes siderophore, classified in class 514, subclass 1. Applicant reserves the right to pursue examination of the non-elected claims in continuation or divisional applications.

Applicant respectfully requests reconsideration and withdrawal or modification of the restriction requirement. "There are two criteria for a proper requirement for restriction between patentably distinct inventions:(A) The inventions must be independent or distinct as claimed; and (B) There must be a serious burden on the examiner if restriction is required" (M.P.E.P. §803, emphasis added, citations omitted). It is Applicant's position that the continued consideration of the inventions as claimed does not place a serious burden on the Examiner.

The Action asserts "the search is placed in different classes and subclasses for many of the groups." An Office Action on the merits was mailed out on January 11, 2002, thus, the pending claims have already been searched. Thus, the assertion that the groups belong to different classes is irrelevant, as no additional search is required.

It is Applicant's position that a new search is not required based on the 2 new claims (claims 41 and 42) added in the response mailed April 11, 2002, because the subject matter of claims 41 and 42 has already been searched. New claim 41 is identical to claim 29

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except claim 41 recites "consisting essentially of" while claim 29 recites "comprising." Likewise, new claim 42 is identical to claim 33 except claim 42 recites "consisting essentially of" while claim 33 recites "comprising." In the Restriction Requirement dated July 2, 2002, the nearly identical claims 29 and 41 were asserted to belong to different classification groups. Applicant submits that two claims that differ only as to the use of the terms "comprising" and "consisting essentially of" should not be placed in separate classification groups; the search of the claim reciting "comprising" (i.e., claim 29, which has already been searched) necessarily includes the claims reciting "consisting essentially of."

It is also Applicant's position that a new search is not required based on the amendments made to claims 8, 9, 28-30, 33, and 36-38 made in the response mailed April 11, 2002, because the amendments made to the claims do not result in a change in the classification of the claims.

Further, the review by the Examiner of the documents present in the Information Disclosure Statement mailed April 11, 2002, does not constitute a search. "Planning a thorough search of the prior art requires three distinct steps by the examiner: (A) identifying the field of search; (B) selecting the proper tool(s) to perform the search; and (C) determining the appropriate search strategy for each search tool selected" (M.P.E.P §904.02). The review of the documents present in the Information Disclosure Statement does not require any of these steps. Moreover, the review of the documents present in the Information Disclosure Statement mailed April 11, 2002, does not constitute a serious burden on the Examiner.

It is respectfully submitted that the continued consideration of the inventions as claimed does not place a serious burden on the Examiner. Accordingly, it is requested that the restriction requirement be reconsidered and withdrawn or modified.

The Restriction Requirement states that a telephone call was made to the undersigned on June 28, 2002. The undersigned respectfully submits that he is not aware of such a telephone call.

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Request for Rejoinder under 37 CFR §1.121

Applicant appreciates the indication that the Examiner is willing to consider rejoinder of the groups or specific groups of claims. In the event that the non-elected claims are withdrawn from consideration, Applicant requests the opportunity to amend the non-elected claims (in particular, the claims of Groups II, III, IV, V, and XIV) to include all the limitations of the examined product claim 29, and, pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86), withdrawal of the restriction requirement as it relates to the non-elected claims, and rejoinder and examination the non-elected claims.

The Examiner is invited to contact Applicant's Representatives, at the below-listed telephone number if prosecution of this application may be assisted thereby.

CERTIFICATE UNDER 37 C.F.R. 1.10:

The undersigned hereby certifies that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR §1.10 on the date indicated below and is addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

Katie Muetting
Katie Muetting

"Express Mail" mailing label number:
EV 152753057 US
Date of Deposit: August 12, 2002

Date

DLP/skd

Respectfully submitted for

Daniel J. O'SULLIVAN

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